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EXAMINER MORRISON, THOMAS A				
ART UNIT		PAPER NUMBER		
3653				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary**Application No.**

10/589,153

Applicant(s)VAN DEN AKER, MARTINUS
CORNELIUS**Examiner**

THOMAS A. MORRISON

Art Unit

3653

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 July 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-46 is/are pending in the application.
- 4a) Of the above claim(s) 45 and 46 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of claims 24-44 in the reply filed on 7/31/09 is acknowledged. Claims 45-46 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 7/31/09.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 31-44 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. More specifically, MPEP, section 2173.05(p) states, "A single claim which claims both an apparatus and the method steps of using the apparatus is indefinite under 35 U.S.C. 112, second paragraph." *Id.* Claim 31 and its dependent claims recite a device for carrying out a method according to claim 24, and claim 24 and its dependent claims recite elements of the apparatus, while claim 24 and its dependent claims recite method steps. Since claim 31 and its dependent claims claim both an apparatus and the method steps of using the apparatus, these claims are indefinite.

The term "near" in claim 38 is a relative term which renders the claim indefinite. The term "near" is not defined by the claim, the specification does not provide a

standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. As such, claim 38 is indefinite.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 31-44 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. In particular, claims 31-44 are directed to neither a "process" nor a "machine," but rather embrace or overlap two different statutory classes of invention set forth in 35 U.S.C. 101 which is drafted so as to set forth the statutory classes of invention in the alternative only. See, MPEP, section 2173.05(p). More specifically, claims 31-44 recite both a process and a machine.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 24-28, 30-35 and 39-44, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,433,430 (Straessler et al.).

Regarding claim 24, Figs. 1-5 disclose a method for transporting a sheet, comprising the following steps:

moving the sheet (S) in a first direction by applying a first carrier (7) which is movable in the first direction and which is capable of retaining the sheet by means of a surface force (e.g., friction), wherein a retainer area of the sheet (S) is retained by the first carrier (7) and a conveyance area of the sheet (S) projects with respect to the first carrier (7);

conveying the sheet from the first carrier (7) to a second carrier (including 13 and 14) which is movable in a second direction and which is capable of retaining the sheet by means of a surface force (e.g., friction), wherein the sheet (S) is put in a conveyance position (near 11) by the first carrier (7), in which position the complete conveyance area overlaps the second carrier (including 13 and 14); and

moving the sheet (S) in the second direction by applying the second carrier (including 13 and 14); wherein, during the movement of the sheet (S) in the first direction, guidance of a guidance area of the sheet, which comprises at least a portion of the conveyance area of the sheet (S), takes place by applying guiding means (8), which guidance is cancelled when the sheet has reached the conveyance position (near 11).

Regarding claim 25, Figs. 1-5 disclose that the guiding means (8) are capable of retaining the guidance area of the sheet (S) by means of a surface force.

Regarding claim 26, Figs. 1-5 disclose that the guiding means (8) are adapted to guaranteeing that the guidance area of the sheet and the retainer area of the sheet (S) extend at a substantially equal level. See also col. 2, lines 51-54.

Regarding claim 27, Figs. 1-5 disclose that the guiding means (8) are movable in the first direction.

Regarding claim 28, Figs. 1-5 disclose that, during the time that guidance of the guidance area of the sheet (S) takes place, a speed at which the guiding means (8) are moved is substantially equal to a speed at which the first carrier (7) is moved.

Regarding claim 30, Figs. 1-5 disclose that the guidance area comprises a portion of the conveyance area of the sheet (S), which is a front portion in the direction.

Regarding claim 31, as best understood, Figs. 1-5 show a device for carrying out a method according to claim 24, comprising:

a movable first carrier (7) which is adapted to moving sheets (S) in a first direction and retaining sheets (S) by means of a surface force (e.g., friction);

a movable second carrier (including 13 and 14) which is adapted to moving sheets (S) in a second direction and retaining sheets (S) by means of surface force (e.g., friction), wherein the first carrier (7) and the second carrier (including 13 and 14) adjoin each other in a close-fitting fashion at the location of a conveyance region (near 11); and

guiding means (8) for guiding a portion of sheets which are retained by the first carrier (7), as far as in the conveyance region (near 11).

Regarding claim 32, as best understood, Figs. 1-5 show that the guiding means (8) are adapted to retaining sheets by means of a surface force.

Regarding claim 33, as best understood, Figs. 1-5 show that contacting areas of the first carrier (7) and contacting areas of the guiding means (8), which are adapted to

contacting the sheets (S), are located on a substantially equal level. See also col. 2, lines 51-54.

Regarding claim 34, as best understood, Figs. 1-5 show that the guiding means (8) are movable in the first direction.

Regarding claim 35, as best understood, Figs. 1-5 show that the guiding means (8) comprise an endless conveyor belt.

Regarding claim 39, as best understood, Figs. 1-5 show a guiding device (including 8, 5 and 6) for guiding a web, comprising a frame (3 or 5) and a guiding member (8) which is destined to contact the web, wherein the guiding member (8) is movable with respect to the frame (3 or 5).

Regarding claim 40, as best understood, Figs. 1-5 show that the guiding member (8) is adapted to contacting exclusively one side (bottom) of the web.

Regarding claim 41, as best understood, Figs. 1-5 show that the guiding member (8) is movable with respect to the frame (3 or 5) along a substantially straight line in one direction, wherein the one direction is a horizontal direction.

Regarding claim 42, as best understood, Figs. 1-5 show moving means (including 23) for moving the guiding member (8) with respect to the frame (3 or 5); and controlling means (i.e., whatever structure operates the motor 23) for determining the position of the guiding member (8) with respect to the frame (3 or 5) and controlling the moving means (23); wherein the moving means (23) comprise an electric motor.

Regarding claim 43, as best understood, Figs. 1-5 show that the guiding member (8) comprises at least one rotatably arranged guiding roller (6).

Regarding claim 44, as best understood, Figs. 1-5 show at least one guiding device according to claim 39. See elements of claim 39 above.

5. Claims 24-27, 29-35, 39-44, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,433,430 (Straessler et al.).

Regarding claim 24, Figs. 1-5 disclose a method for transporting a sheet, comprising the following steps:

moving the sheet (S) in a first direction by applying a first carrier (7) which is movable in the first direction and which is capable of retaining the sheet (7) by means of a surface force (e.g., friction), wherein a retainer area of the sheet (S) is retained by the first carrier (7) and a conveyance area of the sheet (7) projects with respect to the first carrier (7);

conveying the sheet (S) from the first carrier (7) to a second carrier (13) which is movable in a second direction and which is capable of retaining the sheet (S) by means of a surface force (e.g., friction), wherein the sheet (S) is put in a conveyance position (near 11) by the first carrier (7), in which position the complete conveyance area overlaps the second carrier (13); and

moving the sheet (S) in the second direction by applying the second carrier (13); wherein, during the movement of the sheet (S) in the first direction, guidance of a guidance area of the sheet (S), which comprises at least a portion of the conveyance area of the sheet (S), takes place by applying guiding means (14), which guidance is cancelled when the sheet (S) has reached the conveyance position (near 11).

Regarding claim 25, Figs. 1-5 disclose that the guiding means (14) are capable of retaining the guidance area of the sheet (S) by means of a surface force (e.g., friction).

Regarding claim 26, Figs. 1-5 disclose that the guiding means (14) are adapted to guaranteeing that the guidance area of the sheet (S) and the retainer area of the sheet (S) extend at a substantially equal level.

Regarding claim 27, Figs. 1-5 disclose that the guiding means (14) are movable in the first direction.

Regarding claim 29, Figs. 1-5 disclose that the cancellation of the guidance of the guidance area of the sheet (S) takes place by realizing a speed difference of the guiding means (14) and the first carrier (7).

Regarding claim 30, Figs. 1-5 disclose that the guidance area comprises a portion of the conveyance area of the sheet (S), which is a front portion in the direction.

Regarding claim 31, as best understood, Figs. 1-5 show a device for carrying out a method according to claim 24, comprising:

a movable first carrier (7) which is adapted to moving sheets (S) in a first direction and retaining sheets (S) by means of a surface force (e.g., friction);

a movable second carrier (13) which is adapted to moving sheets (S) in a second direction and retaining sheets (S) by means of surface force (e.g., friction), wherein the first carrier (7) and the second carrier (13) adjoin each other in a close-fitting fashion at the location of a conveyance region (near 11); and

guiding means (14) for guiding a portion of sheets which are retained by the first carrier (7), as far as in the conveyance region (near 11).

Regarding claim 32, as best understood, Figs. 1-5 show that the guiding means (14) are adapted to retaining sheets by means of a surface force (e.g., friction).

Regarding claim 33, as best understood, Figs. 1-5 show that contacting areas of the first carrier (7) and contacting areas of the guiding means (14), which are adapted to contacting the sheets (S), are located on a substantially equal level.

Regarding claim 34, as best understood, Figs. 1-5 show that the guiding means (14) are movable in the first direction.

Regarding claim 35, as best understood, Figs. 1-5 show that the guiding means (14) comprise an endless conveyor belt.

Regarding claim 39, as best understood, Figs. 1-5 show a guiding device (14) for guiding a web, comprising a frame (Fig. 3) and a guiding member (14) which is destined to contact the web, wherein the guiding member (14) is movable with respect to the frame (Fig. 3).

Regarding claim 40, as best understood, Figs. 1-5 show that the guiding member (14) is adapted to contacting exclusively one side of the web.

Regarding claim 41, as best understood, Figs. 1-5 show that the guiding member (14) is movable with respect to the frame (Fig. 3) along a substantially straight line in one direction, wherein the one direction is a horizontal direction.

Regarding claim 42, as best understood, Figs. 1-5 show moving means (23 and the sheet between elements 23 and 24) for moving the guiding member (14) with

respect to the frame (Fig. 3); and controlling means (whatever structure controls element 23) for determining the position of the guiding member (14) with respect to the frame (Fig. 3) and controlling the moving means; wherein the moving means (23) comprise an electric motor.

Regarding claim 43, as best understood, Figs. 1-5 show that the guiding member (14) comprises at least one rotatably arranged guiding roller (17).

Regarding claim 44, as best understood, Figs. 1-5 show at least one guiding device (14) according to claim 39. See elements of claim 39 above.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 36 is rejected under 35 U.S.C. 103(a) as being unpatentable over Straessler as applied to claim 35 above, and further in view of U.S. Patent No. 5,188,010 (Borchardt et al.). Regarding claim 36, as best understood, Figs. 1-5 show that the conveyor belt (8 or 14) comprises at least two different types of areas, but does not explicitly disclose that at the location of one type of area a dimension of the conveyor belt (8 or 14) in a transverse direction is different than at the location of another type of area, as claimed.

Borchardt discloses that it is well known in the art that belts are made with tolerances in the width dimensions of such belts and outlines methods for minimizing

such width tolerances. See, e.g., Abstract, col. 2, lines 3-6 and col. 4, lines 17-25. As such, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the apparatus of Straessler with a belt that has some degree of width tolerance such that at the location of one type of area a dimension of the conveyor belt of Straessler in a transverse direction (width) is different than at the location of another type of area, because width tolerance of belts is common in the art, as taught by Borchardt. Thus, all of the limitations of claim 36 are met by the cited combination of references.

7. Claims 37-38, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Straessler as applied to claim 31 above, and further in view of U.S. Patent No. 5,695,185 (Bell). Regarding claim 37, as best understood, Figs. 1-5 show a frame (21) for receiving a reel having a web which is destined to receive the sheets and to be connected to the sheets, but does not explicitly disclose a gluing device, as claimed. With regard to the recitation "a frame **for receiving a reel having a web which is destined to receive the sheets and to be connected to the sheets**" in claim 37, the bolded portion of this recitation is merely a statement of intended use that does not distinguish claim 37 from the prior art apparatus of Straessler. Likewise, in the recitation "a gluing device **for applying glue to the web**", the bolded portion of the recitation is merely a statement of intended use that does not distinguish claim 37 from the prior art apparatus of Straessler.

Straessler discloses an apparatus that handles shingled folded printed products.

Similarly, Bell discloses an apparatus that handles shingled folded printed products, and discloses that it is well known in the art to perform additional finishing on such folded printed products such as gluing, stapling and trimming. See, e.g., col. 1, lines 1-30. As such, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the apparatus of Straessler with a gluing device for the purpose of finishing the folded printed products handled by the apparatus of Straessler, because Bell discloses that it is common in the art to finish folded printed products by gluing such products. Thus, all of the limitations of claim 37 are met by the cited combination of references.

Regarding claim 38, as best understood, the gluing device is arranged near the frame (21).

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to THOMAS A. MORRISON whose telephone number is (571)272-7221. The examiner can normally be reached on M-F, 8am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Mackey can be reached on (571) 272-6916. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Patrick H. Mackey/
Supervisory Patent Examiner, Art
Unit 3653

10/10/09